

### REMARKS

Claims 1-13 and 16-26 are pending, with claims 1, 20, and 23 being independent. Claim 1 has been amended; claims 8-10 have been withdrawn; claims 14 and 15 have been canceled; and claims 16-26 have been added. Support for the amendment to claim 1 and the new claims can be found at least at the following locations in the originally-filed specification:

Claim 1: Page 2, lines 10-12; Page 3, lines 2-4; and Figs. 3A-4;  
Claims 16 and 24: Page 2, lines 22-24;  
Claims 17 and 25: Page 2, lines 23-24;  
Claims 18 and 21: Page 2, lines 19-20;  
Claims 19, 22, and 26: Fig. 1;  
Claim 20: Page 2, lines 1-24; Page 3, lines 2-4; and Figs. 3A-4; and  
Claim 23: Page 2, line 32 to page 3, line 12 and Figs. 3A-3E.

No new matter has been added.

Claims 1-15 have been restricted. Applicant affirms the election without traverse of Group I, Species 1, which includes claims 1-7 and 11-13. New claims 16-26 also are believed to be directed to the elected species, or to be generic to that species.

Independent claim 1 recites a puzzle storage device including a puzzle assembly mat for receiving one or more puzzle pieces, and an inflatable tube around which the puzzle assembly mat and the one or more puzzle pieces may be rolled while the inflatable tube is inflated.

Claims 1, 2, 12, and 13 have been rejected as being anticipated by U.S. Patent No. 5,966,757 (Sullivan '757). Applicant requests withdrawal of this rejection because Sullivan '757 fails to describe or suggest an inflatable tube around which a puzzle assembly mat and one or more received puzzle pieces may be rolled while the inflatable tube is inflated, as recited in claim 1. Sullivan '757 relates to a beach towel 12 having an inflatable compartment 42 that acts as a pillow when the towel 12 is opened flat on the ground. See Sullivan '757 at abstract. Sullivan '757 never suggests that the towel 12 is rolled around the inflatable compartment 42 while the inflatable compartment 42 is inflated. See Sullivan '757 at col. 4, lines 29-32. Moreover, Sullivan '757 never describes or suggests that the towel 12 receives puzzle pieces. Rather, the towel 12 in Sullivan '757 is used as a beach towel or blanket.

The Examiner apparently realizes these deficiencies in Sullivan '757 and argues that the towel 12 in Sullivan '757 is "inherently capable of being used for puzzle storage." The Examiner points to the puzzle storage device of U.S. Patent No. 5,375,707 (Richer) as extrinsic evidence of the missing descriptive matter. In Richer, the puzzle pieces are placed on a carpet 1 and the carpet 1 and the puzzle pieces are then rolled around a solid and non-inflatable tube 3. See Richer at abstract and col. 2, lines 23-34. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference" and it is not sufficient that "a certain thing may result from a given set of circumstances." See MPEP §2112 IV. Accordingly, if there exists even a possibility that the missing descriptive matter is not in the thing described in the reference, then a rejection based on inherency is improper.

First, there is nothing in Richer that makes it clear that the towel 12 in Sullivan '757 necessarily receives one or more puzzle pieces. To the contrary, Richer's carpet 1 is designed to receive puzzle pieces, unlike the towel 12 of Sullivan '757. As Richer explains the carpet 1 "is made of a felt material which has just sufficient surface roughness to prevent a piece of puzzle to easily slide thereover." See Richer at col. 2, lines 26-30. There is no indication in Sullivan '757 that the towel 12 would be configured to be suitable to receive a puzzle piece. The towel 12 in Sullivan '757 is used as a beach towel and there is nothing in Richer that indicates that a beach towel would receive one or more puzzle pieces. Thus, there is at least the possibility that the towel 12 does not receive one or more puzzle pieces.

Second, there is nothing in Richer that makes it clear that the towel 12 necessarily would be rolled around the compartment 42 when the compartment 42 is inflated. To the contrary, it is evident from Fig. 4 of Sullivan '757 that the towel 12 in Sullivan '757 is rolled around the compartment 42 when the compartment is deflated. Were it otherwise, then rolled-up towel/blanket system 10 would not be shaped as a smooth cylinder, as shown in Fig. 4 of Sullivan '757. Rather, the rolled-up towel/blanket system 10 would be bulging in the region of the compartment 42 because the compartment 42 does not extend the entire length of the blanket,

as shown in Fig. 5 of Sullivan '757. For at least these reasons, a rejection based on inherency is improper.

Claims 2, 12, and 13 depend from claim 1 and are allowable for at least the reasons that claim 1 is allowable.

Claim 3 has been rejected as being obvious over Sullivan '757 in view of U.S. Patent No. 6,131,219 (Roberts). Claim 3 depends from claim 1, which was rejected as being anticipated by Sullivan '757. Roberts fails to cure the deficiencies of Sullivan '757 to describe or suggest an inflatable tube around which a puzzle assembly mat and one or more received puzzle pieces may be rolled while the inflatable tube is inflated, as recited in claim 1. Roberts relates to an inflatable pillow. See Roberts at abstract and Fig. 1. However, Roberts never describes or suggests a puzzle assembly mat that can be rolled around the inflatable pillow. For at least this reason, claim 1 is allowable over Sullivan '757 in view of Roberts. Claim 3 depends from claim 1 and is allowable for at least the reasons that claim 1 is allowable.

Claims 4-7 and 11 have been rejected as being obvious over Sullivan '757 in view of U.S. Patent No. 6,182,309 (Sullivan '309). Claims 4-7 and 11 depend from claim 1, which was rejected as being anticipated by Sullivan '757. Sullivan '309 fails to cure the deficiencies of Sullivan '757 to describe or suggest an inflatable tube around which a puzzle assembly mat and one or more received puzzle pieces may be rolled while the inflatable tube is inflated. Sullivan '309 relates to a pillow 30 permanently attached to one end of a beach towel 20. See Sullivan '309 at abstract and Fig. 1. However, the pillow 30 in Sullivan '309 is not inflatable and the beach towel 20 in Sullivan '309 does not receive one or more puzzle pieces. For at least this reason, claim 1 is allowable over Sullivan '757 in view of Sullivan '309. Claims 4-7 and 11 depend from claim 1 and are allowable for at least the reasons that claim 1 is allowable.

Claims 16-19 depend from claim 1 and are allowable for at least the reasons that claim 1 is allowable.

Claim 20 recites a puzzle storage device including a puzzle assembly mat, an inflatable tube, and straps to secure the puzzle assembly mat around the inflatable tube. The puzzle assembly mat has a rough surface for receiving one or more puzzle pieces and for preventing the

one or more received puzzle pieces from sliding. The puzzle assembly mat and the one or more puzzle pieces may be rolled around the inflatable tube. The inflatable tube is detached from the puzzle assembly mat. Claim 20 is in condition for allowance because none of the cited art, alone or in combination, describes or suggests that a puzzle assembly mat and one or more puzzle pieces, which are received on the puzzle assembly mat, may be rolled around an inflatable tube. Moreover, one of ordinary skill in the art would not have been motivated to modify any of the cited references to obtain such a puzzle storage device.

Claim 21 and 22 depend from claim 20 and are allowable for at least the reason that claim 20 is allowable.

Claim 23 recites a puzzle storage device including one or more puzzle pieces, a puzzle assembly mat for receiving the one or more puzzle pieces, and an inflatable tube around which the puzzle assembly mat and the one or more puzzle pieces may be rolled. Claim 23 is in condition for allowance because the cited art, alone or in combination, fails to describe or suggest that a puzzle assembly mat and one or more puzzle pieces received on the puzzle assembly mat may be rolled around an inflatable tube. Moreover, one of ordinary skill in the art would not have been motivated to modify any of the cited references to obtain such a puzzle storage device.

Claims 24-26 depend from claim 23 and are allowable for at least the reason that claim 23 is allowable.

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Enclosed is a check for a one-month extension of time fee and for additional claims.  
Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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